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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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10

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/172,689

Applicant(s)

BISH ET AL.

Examiner

Susan B. McCormick

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2000.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

Detailed Action

Status of Application

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1661.

Objection to the Oath

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: A new oath or declaration properly reciting the non-signing inventor's address and signed by the two signing joint inventors on behalf of themselves and the non-signing inventor must be filed.

Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a process for enhancing flower induction in strawberries, classified in class 47, subclass 58.1.
- II. Claim 17, drawn to stawberry plant, classified in class 800, subclass 298.

The inventions are distinct, each from the other because: Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially

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different process (MPEP § 806.05(f)). In the instant case, strawberry plants having enhanced flower induction can be produced by application of paclobutrazol, for example. Furthermore, different searches are required for the two inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Saliwanchik on April 30, 2001, a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-16. Affirmation of this election must be made by Applicant in replying to this Office action. Claim 17 withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

35 U.S.C. 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-16 are rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

More specifically:

Claims 1, 6 and 10 are vague and indefinite as no duration is given for said method which the strawberry plant is exposed. The term "enhance" is a relative term but no standard for comparison is given. Also, enhanced in what way? i.e. earlier flowering, more flowers, or flowers all appear at once?

Claim 6 and 10 are indefinite because it is not clear what conditions existed before "reduction." Is reduction relative to the day before treatment or relative to a set photoperiodic regime for a given length of time or something else?

Claim Rejection 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Izhar et al.

(U.S. Patent 5,444,179, column 4).

Claims 1-3, 5-12, 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Heide, where strawberry plants were transferred from 24°C and continuous light to reduced temperatures and photoperiod. Both treatments increased flower induction, see Figs. 1 and 2 (page 22).

Claims 1-3, 5-6, 8-12, 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sonsteby (page 610, second paragraph and Table 1).

Claim Rejection 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention in not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 are rejected over either one of Heide or Sonsteby; in view of Izhar.

Heide and Sonsteby each teach reducing temperatures and photoperiod to enhance flowering in strawberry plants, as cited above. They don't teach the specific warmer temperatures recited in some claims- 30°C day; 30°C night. However, Heide and Sonsteby used varieties adapted for Scandanavia. Izhar disclose a new type of strawberry which can flower even with high night temperatures (>26°C).

It would have been obvious to a person of ordinary skill in the art to modify the method of Heide or Sonstebyby using higher temperatures, as taught by Izhar. One would have been motivated to do so given the expectation that this would enhance flower initiation in cultivars

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adapted to warmer climates. Photoperiod and temperatures are result-effective variables which would have been routinely optimized by one of ordinary skill in the art. It would have been obvious to use known methods manipulating photoperiod and temperatures with a variety adapted to warm temperatures and to use warmer temperatures. Motivation could be as simple as saving money on air conditioning. It would have been obvious to cool the plant growth area as little as necessary to achieve the desired enhancement in flower induction. Thus the invention as a whole was prima facie obvious to a person of ordinary skill in the art at the time the invention was made.

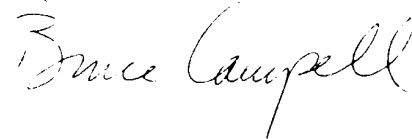
Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.



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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600